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12M1/0612

GRUMELING M
EXAMINER

ART UNIT

PAPER NUMBER

1202

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This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

DATE MAILED: 06/12/95

☒ This application has been examined ☐ Responsive to communication filed on ____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 MONTHS from the date of this letter.
Failure to respond within the time period will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENTS ARE PART OF THIS ACTION:

- ☐ Notice of References Cited by Examiner, PTO-892.
- ☐ Notice re Patent Drawing, PTO-948.
- ☒ Notice of Art Cited by Applicant, PTO-1449
- ☐ Notice of Informal Patent Application, Form PTO-152.
- ☐ Information on How to Effect Drawing Changes, PTO-1474.
- ☐ _____

Part II SUMMARY OF ACTION

- ☒ Claims 1-23 are pending in the application.
Of the above claims, 23 are withdrawn from consideration.
- ☐ Claims ____ have been cancelled.
- ☐ Claims ____ are allowed.
- ☒ Claims 1-3, 6-7, 10-11, 15-16, 19, 21 and 22 are rejected.
- ☒ Claims 4-5, 8-9, 12-14, 17-18 and 20 are objected to.
- ☐ Claims ____ are subject to restriction or election requirement.
- ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
- ☐ Formal drawings are required in response to this Office action.
- ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable. ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
- ☐ The proposed additional or substitute sheet(s) of drawings, filed on ____ has (have) been ☐ approved by the examiner. ☐ disapproved by the examiner (see explanation).
- ☐ The proposed drawing correction, filed on ____ has been ☐ approved. ☐ disapproved (see explanation).
- ☒ Acknowledgment is made of the claim for priority under 35 USC 119. The certified copy has ☐ been received ☒ not been received
☐ been filed in parent application, serial no. ____; filed on ____.
- ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
- ☐ Other

EXAMINER'S ACTION

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Restriction to one of the following inventions is required under 35 U.S.C. § 121:

I. Claims 1-22, drawn to compounds, compositions and methods of use, classified in Class 514, subclass 252 and 272.

II. Claim 23, drawn to a process of making compounds, classified in Class 544, subclasses 295, 322, 331 and 332.

Inventions II and I are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (M.P.E.P. § 806.05(f)). In the instant case, the products could be made by the process described by Hubele et al.

Because these inventions are distinct for the reasons given above and have acquired separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Ms. Karen Kaiser on 3/23/95 a provisional election was made with traverse to prosecute the invention of group I, claims 1-22. Affirmation of this election must be made by applicant in responding to this Office action. Claim 23 is withdrawn from further consideration

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by the Examiner, 37 C.F.R. § 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to teach how to make the claimed invention. The compound claims 1-3, 6-7 and 10-11 are drawn to compounds of the formula (I) in claim 1 wherein R₁ may be 4-pyrazinyl, 1-methyl-1H-pyrrolyl, phenyl (which is substituted by NH₂ or alkylamino), indolyl, imidazolyl bonded at a 5-membered ring carbon of pyridyl. Looking into the specification, it is apparent that only the pyridyl and indolyl compounds are exemplified. Therefore the source of the starting materials of formula (VII) is not apparent. It is noted that 4-pyrazinyl is bonded through a ring nitrogen whereas the pyridyl and indolyl moieties are bonded through ring carbons and are therefore not analogous in structure (and consequently in chemical properties) therefore the general method of preparing the pyrazine starting material corresponding to formula VII would not be expected to be the same as that for indolyl or pyridyl. The same can be said

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for benzimidazolyl when it is bonded through the ring nitrogen (as appears to be possible since indolyl is not limited to the ring carbon bonded species.) Since the compound claims have not been enabled with respect to a process of making several of the compound species, neither are the composition claim 21 or the method of use claim 22 which depend therefrom.

Claims 1-3, 6-7, 10, 21-22 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claims 15, 16 and 19 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- 1) In claim 15, second line, there is an "or" missing between "pyridyl" and ",3-indolyl".
- 2) In claim 16, second line, there is an "or" missing between "pyridyl and "3-indolyl".
- 3) In claim 19, line 1, "Nitro" is capitalized.

Claims 4, 5, 8, 9, 12-14, 17, 18 and 20 are objected to as being dependent from a rejected base claim but would be allowable if limited to the subject matter of the claims including all the limitations of the base claims and any intervening claims.

The claims are defined over the prior art of record because the prior art neither teaches nor suggests compounds of formula

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(1) possessing R¹ of the values recited in the claims and at the same time possessing at least one phenyl substituent chosen from NO₂, OAk-halo, -N(CO)N- and -NCOO-. The teaching of the Hubele et al. reference (specifically at column 1, lines 45-47) generically circumscribes compounds of the instant invention. However, the disclosure is so broad (i.e. saturated or unsaturated heterocyclic radical containing one or more hetero atoms) and the utility thereof (i.e. herbicides) so disparate from that of the instantly claimed compounds, compositions and methods of use that the reference would fail to suggest to one of ordinary skill in the art to prepare and use the instantly claimed invention.

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew V. Grumbling whose telephone number is (703) 308-4713. The examiner can usually be reached on Monday through Friday from 9:30 a.m. until 6:00 p.m.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1235.

A facsimile center has been established in Group 1200, room 3C10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine are (703) 308-4556 or 305-3592.

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Matthew V. Grumbling
Matthew V. Grumbling
Patent Examiner
GAU 1202
June 8, 1995